

Applicant : William E. Richeson
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REMARKS

The Examiner has withdrawn the rejection of claims 37-45 under § 102(b). Instead, the Examiner has rejected claims 32-35, 37-43, 45, 46, and 47 under 35 U.S.C. § 103(a) as being unpatentable over Grove U.S. Patent No. 4,044,262. Applicant respectfully traverses this rejection and requests reconsideration of the application.

§ 103 REJECTIONS

The Examiner has rejected claims 32-35, 38-43, 45, 46, and 47 under § 103(a) as being unpatentable over Grove U.S. Patent No. 4,004,262. In order to establish a prima facie case of obviousness, the Examiner, among other things, must show that the prior art reference or references teach or suggest all of the claim limitations. *In re Royka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). The burden is on the Examiner to make this showing. *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). Applicant respectfully submits that the Examiner has not met his burden of establishing a prima facie case of obviousness with respect to the rejected claims.

Claims 32-35 recite an electromagnet assembly comprising, among other things, friction material comprising a polymeric donor material and a powder metal housing having a rim with a thickness of between about 0.127 and 0.400 inches. The Examiner states that it would have been obvious to adjust the thickness of the rim of the housing of Grove '262. First, although Grove '262 does disclose an electromagnet having a friction member which may or may not comprise a plastic, there is no indication that the friction material is a donor material in the way that term is used in the present application. Second, the Examiner has not pointed to any disclosure in Grove '262 of any suggestion that the rim of the Grove '262 electromagnet should be modified to

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discover a “optimum or workable range” for the thickness. While the Examiner states that Grove does not need to provide a reason, Grove does not disclose a thickness in the claimed range at all. There is **no** teaching, suggestion, or motivation in Grove for the claimed range. All of the claimed limitations are not taught or suggested and, thus, the Examiner has not made out a *prima facie* case of obviousness.

As to claims 38, 42-43, and 47, these claims recite a metal core having a Young's modulus of between about 6.8 million psi and about 29.5 million psi. In the same regard, claims 40-43 and 46-47 recite a specific yield strength range. The Examiner again states that Grove does not have to disclose a reason for modifying the composition to a specific Young's modulus or yield strength. However, there must be **some** suggestion or motivation for the modification. Grove provides none. It is improper for the Examiner to use hind-sight to reconstruct the Applicant's invention by applying his own motivation. One of ordinary skill in the art reading the Grove '262 patent would not have found it obvious to find an optimum value of these characteristics by reading the Grove '262 reference. Grove '262 provides no teaching or suggestion regarding these characteristics, and therefore it would not have been obvious based on the Grove '262 patent for one of ordinary skill in the art to even consider these characteristics, let alone find the “optimal” ranges for these characteristics.

The Grove '262 reference does not disclose or suggest all of the elements of the rejected claims and, therefore, the § 103 rejections are improper. Applicant respectfully requests that they be withdrawn.

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CONCLUSION

It is believed that the above represents a complete response to the official Office Action. Applicant respectfully submits that the application is in condition for allowance and respectfully requests a notice of allowance.

Respectfully submitted,

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